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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
| 10/537,649 | 02/28/2006 | Yoshimitsu Kagiwada | SHIO-0110 | 4613 |
| 23377 7590 01/18/2007 WOODCOCK WASHBURN LLP CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891 | | | EXAMINER PLUCINSKI, JAMISUE A | |
| | | | ART UNIT 3629 | PAPER NUMBER |
| SHORTENED STATUTORY PERIOD OF RESPONSE | | MAIL DATE | DELIVERY MODE | |
| 3 MONTHS | | 01/18/2007 | PAPER | |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

| | | | |
|------------------------------|----------------------|-----------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/537,649 | KAGIWADA ET AL. | |
| | Examiner | Art Unit | |
| | Jamisue A. Plucinski | 3629 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20060717</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 1 recites the limitation "the order reception information". There is insufficient antecedent basis for this limitation in the claim.
4. Regarding claims 1, 2 and 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
5. Claims 3 and 4 recites the limitation "the information". There is insufficient antecedent basis for this limitation in the claims.
6. It should be noted that the claims are drawn to a system, which is limited to the structural limitations of the system and the capabilities thereof.
7. With respect to Claim 2: The applicant states in the preamble that the invention is directed to a system. Claim 2, then claims "reading the delivery source information..." which is a positive recitation of a method step, therefore causing it to be unclear if the claim is directed to a system or a method.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 2 is rejected under 35 U.S.C. 101 because 32 USC 101 requires that in order to be patentable, the invention must be a “new and useful process, machine, manufacture or composition of matter...” Applicant’s Claim 2, appear to be attempting to embrace or overlap two different statutory classes, as set forth in 35 USC 101. the claims begin by disclosing a system with structural limitation, then claim a positive method step of “reading”.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Guidice et al. (6,463,420).

11. With respect to Claim 1: Guidice discloses a door to door parcel delivery information system (see abstract) comprising:

- a. Commodity information storage means (Column 2, lines 54-65, Column 3, lines 56-65 and Column 4, lines 20-25);

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- b. Door-to-door parcel delivery information storage means (Steps 412 to 420 with corresponding detailed description) capable of storing:
 - i. Billing amount (Column 4, lines 58-65);
 - ii. Delivery state (Column 6, lines 40-67);
 - c. Communication means which communicates with an external device (Column 5, lines 21-37);
 - d. Processing means which controls all other means (Reference numeral 16 with corresponding detailed description).
12. With respect to Claim 2: delivery source information storage means (Column 6, line 1-39).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guidice.

16. With respect to Claim 3: Guidice discloses the use of processing and door-to-door storage means, however fails to disclose the information stored is whether the billing amount is paid.

However, the specific type of information stored being whether the billing has been paid is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The processing steps would be performed the same regardless of what type of material is being shipped. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

17. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Guidice in view of Kadaba (6,539,360).

18. Guidice discloses the use of shipping orders, however fails to disclose the items of the order are fragile articles or pets, and fails to disclose the delivery status is a state of the article or the pet. Kadaba discloses the use of a special handling item shipping and tracking system, which ships and tracks whether a package designated for special handling (such as fragile items, Column 6, lines 1-8) has been applied to the packages (see abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Guidice to include the tracking of special handling items, such as in Kadaba, in order to provide a system

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which applies special handling to fragile items at appropriate times and to determine if there is a reoccurring failure in the special handling of items. (See Kadaba Column 4)

Conclusion

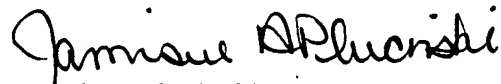
19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kintzer et al. (6,968,328) discloses the use of a tracking system for shipping packages, and Benzos et al. (7,006,989) discloses the use of a delivery and tracking system of a gift.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Plucinski whose telephone number is (571) 272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jamisue Plucinski
Patent Examiner
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